

Application No. 10/049,975
Filed: October 1, 2002
Confirmation No.: 6238
TC Art Unit: 1641

REMARKS

The pending claims are claims 1-6 and 27-55, claims 7-26 having been previously cancelled. Claims 53 and 55 are cancelled herewith.

The Examiner has imposed a restriction requirement, alleging that the invention is drawn to three patentably distinct groups and that these groups do not relate to a single general inventive concept in view of U.S. Patent. No. 4,444,879. The Applicants submit that the Examiner may have misinterpreted the teachings of the '879 patent. In the remarks below, the Applicants present arguments as to why restriction is not proper. If the Examiner continues to maintain the restriction requirement, the Applicants elect Group I drawn to a method of assaying substances (claims 1-6, 27-37, 45-47 and 52-55), with traverse.

In contrast to the allegations made by the Examiner in section 2 of the Office Action, the Applicants submit that the claimed subject matter of the present application is linked by a single general inventive concept in view of the '879 patent based on the following arguments.

It should be noted that the method of assaying substances according to the present application advantageously does not require any washing step, whereas the method disclosed in the '879 patent includes extensive washing which "can often result in inaccurate or completely erroneous results by washing away the weakly bound immunoreagents" and thus, "the loss of bound immunoreactant may adversely affect the immunoassay" (cf., for example, col. 2, lines 34-38 and lines 46-47, and col. 9, lines 37-38, of the '879 patent). Therefore, the teaching of the '879 patent leads a person skilled in the art away from the solution

Application No. 10/049,975
Filed: October 1, 2002
Confirmation No.: 6238
TC Art Unit: 1641

for the problem underlying the present invention, i.e., *inter alia* the provision of a method for assaying substances in which the washing steps usual with an ELISA can be avoided (cf. p. 3, first paragraph of the present application).

Further, the method disclosed in the '879 patent can only be carried out using a solid-phase support comprising a dried film of a synthetic polymeric resin (cf., for example, col. 6, lines 45-46; col. 8, lines 17-19 and lines 36-38, and Fig. 1 of the '879 patent), whereas the method of the present application does not need such a film, the preparation of which is time-consuming, labor-intensive and costly. Thus, a person skilled in the art looking for a solution for the problem underlying the present invention, i.e., *inter alia* the provision of inexpensive sensor chips and cuvettes which are easy to produce and available (cf., p. 3, first paragraph of the present application), would never take the teaching of the '879 patent into account.

Additionally, it is of particular relevance for determining the inventive concept underlying the present invention in view of the disclosure of the '879 patent that the basic principle of assaying the substances in the methods disclosed in said document and the method according to the present invention is completely different. While the '879 patent discloses a method for assaying substances that utilizes an enzymatic reaction for the detection of the substance to be assayed (cf., for example, claim 1 of the '879 patent), i.e., a traditional enzyme linked immunoassay (ELISA), the disadvantages of said assay method, e.g. the time-consuming and complicated handling which comprises several washing and pipetting steps (cf., for

Application No. 10/049,975
Filed: October 1, 2002
Confirmation No.: 6238
TC Art Unit: 1641

example, p. 2, second full paragraph, of the present application), have been overcome by the method according to the present invention, which utilizes the fluorescence produced by an evanescence field of a light source for detecting the substance to be assayed. There is no hint given in the '879 patent towards a need of the replacement of the employed ELISA technique, not to speak of the replacement of said technique by measuring the fluorescence produced by an evanescence field of a light source. Accordingly, the method disclosed in the '879 patent does not solve the problem underlying the present invention, i.e., *inter alia* the provision of a method for assaying substances in which the washing and pipetting steps usual with an ELISA can be avoided (cf., p. 3, first paragraph of the present application).

In summary, an advantageous method of assaying substances, especially biologically active substances, according to the present invention, in which the washing and pipetting steps usual with an ELISA can surprisingly be avoided and the incubation times can be reduced as well as the provision of inexpensive sensor chips and cuvettes which are easy to produce and available being required in said method are neither disclosed nor suggested in the '879 patent. Therefore, the claimed subject matter of the present application is linked by a general inventive concept which is not made obvious to a person skilled in the art by the disclosure content of the '879 patent.

Application No. 10/049,975
Filed: October 1, 2002
Confirmation No.: 6238
TC Art Unit: 1641

Applicants reserve all rights to the unelected claims for future prosecution but hereby authorize the Examiner to cancel them as he deems necessary for the prosecution of the present application.

Respectfully submitted,

MANFRED SCHAWALLER, ET AL.

By: Holliday C. Heine
Holliday C. Heine, Ph.D.
Registration No. 34,346
Attorney for Applicant(s)

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
Ten Post Office Square
Boston, MA 02109

Telephone: (617) 542-2290
Telecopier: (617) 451-0313

HCH/mc/330512-1